

REMARKS

Claims 2 and 4-21, 23-30 are pending in this application. Claim 22 has been canceled. Claims 4, 17, 18, 20, 23, 25, 27, 28, 29, 30 have been amended. As to the amendment to claim 23, see, e.g., Applicants' specification at page 4, line 20. The amendment to claims 17-18, 20 to delete "textile fibers", "textile pieces" and "cork flour" and the cancellation of claim 22 are consistent with the claims in the German counterpart application. The nature of the amendments is such as to admit of their entry at this procedural stage, as they should not require further search.

As a preliminary matter, please note the recent filing of the Information Disclosure Statement on January 12, 2007 as well as the Information Disclosure Statement submitted herewith with English-language translation.

At paragraph 1 of the office action, the specification has been objected to. The Examiner states: "Antecedence has not been found within the specification for claiming that the molecular weight of claim 11 is weight average molecular weight." Applicants respond as follows. Applicants' original claim 11 is part of the specification, and the original claim 11 recites "molecular weight (weight average)." Therefore the recitation is proper.

At paragraph 2 of the office action, the amendment filed June 21, 2005 has been objected to under 35 U.S.C. 132(a) as introducing new matter. To advance prosecution, the objected-to recitation in the amendment has been removed from the specification.

At paragraph 3 of the office action, Claims 2 and 4-30 have been rejected under 35 U.S.C. 112, second paragraph, as indefinite.

[1] Regarding claims 17, 18 and 23, the Examiner states that "it is unclear how the gel can be clear since it includes opaque particles. It is not clear if the 'optically clear' limitation is to apply to the gel sans particles." [2] The Examiner comments that claim 23 fails to further limit claim 18.

Applicants respond as follows. The gel is as clear as glass in its basic state and the phrase "optically clear" refers to the gel in its basic state. "The combination of the gel, which is as clear as glass in the basic state, with the irregular solid gives an attractive appearance to the composite material". (Applicants' specification, page 4, lines 12-13.) For example, "The composite

material is visibly grainy.” (Id., page 4, line 10.) “Since the particles can be recognized discretely, a visually novel gel composite material is produced.” (Id., page 3, lines 27-28.) The appearance of the composite material of this invention may be visualized as that of a compacted/molded coarse-grain cork material (for example, for shoe soles).

[3] Regarding claims 4, 17, 18 and 30, the Examiner states that “it is unclear what limitation is to be conveyed by ‘substantially.’”

Applicants respond as follows. The claims are amended to remove the word “substantially” added by previous amendment.

Reconsideration and withdrawal of the rejection under 35 U.S.C. 112, second paragraph, are respectfully requested.

At paragraph 5 of the office action, claims 2 and 4-30 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that “Applicants have failed to provide adequate support for the amendments to claims 4, 17, 18 and 25-30.” The Examiner refers to claim amendments reciting “substantially” and “about”.

Applicants respond as follows. The terms “substantially” and “about” on which this rejection was based have been avoided in amending the claims above.

Reconsideration and withdrawal of the rejection under 35 U.S.C. 112, first paragraph, are respectfully requested.

At paragraph 6 of the office action, claims 2 and 4-30 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Schapel et al. (‘834) in view of Ehrlich, Jr. (‘702) and Fracalossi et al. (‘221). The Examiner admits that “Schapel et al. fail to specifically recite the use of coarse materials to form a composite.” The Examiner’s position (citing Ehrlich, Jr. (column 2, lines 37+), and Fracalossi et al. (column 3)) is that it would have been obvious to incorporate “coarse” particulate materials into the composition of Schapel et al., so as to obtain materials having improved properties as compared to the properties of the non-particulate containing compositions. In paragraph 9 of the office action, the Examiner indicates that he views the cited particles as of a size comparable to that of Applicants’. The Examiner states that the foam particles or chips disclosed in Fracalossi are 6-12 mm in diameter (citing column 4, line 16).

Applicants respectfully traverse this obviousness rejection.

As the Examiner admits, Schapel fails to disclose “coarse-grain particles”. Additionally, Schapel fails to disclose that the coarse-grain particles are “distributed therein” in the gel. Schapel also fails to disclose, specifically, that the coarse-grain particles are “selected from the group consisting of cork pieces, wood pieces, wood chips, and foam flakes”. Schapel also fails to teach that “the diameter of the coarse-grain solid particles is in a range between 0.1 mm to 15 mm”. Schapel also fails to teach a material in which the “particles can be visually recognized.”

In Schapel, titled “Gel compounds, their production and use,” there is teaching that “The fillers and/or additives known per se from polyurethane chemistry optionally present in the gel compounds according to the invention may be, for example, inorganic and/or organic fillers, coloring agents, water-binding agents, surface-active agents, plant protection agents, extending agents and/or plasticizers.” (Sentence bridging columns 6-7.) However, none of the many optional fillers and additives in Schapel are cork pieces, wood pieces, wood chips, or foam flakes, as recited by Applicants.

A person of ordinary skill in the art would lack motivation to look to either Fracalossi et al., or to Ehrlich, Jr. to modify the gels of Schapel, as the Examiner theorizes, because Fracalossi and Ehrlich are directed to foams, not to gels. Both secondary references fail to teach or disclose working with gels.

Importantly, none of the three references discloses use of cork pieces, wood pieces, wood chips, or foam flakes as recited by Applicants.

Also, a composite material as claimed by Applicants provides unexpectedly superior results compared to Schapel’s materials, as to visual appearance. (See Applicants’ specification at pages 3-4.)

Applicants also note that their dependent claims are more distinguished from Schapel than the Examiner has yet admitted.

Regarding dependent claim 2, Applicants note that this is additionally distinguished from Schapel in that Schapel fails to disclose a composite material having a lowered loss factor compared to a polyurethane gel alone.

Regarding dependent claim 23, Schapel fails to disclose a visibly grainy appearance of a material.

For brevity and simplicity, Applicants do not submit additional distinguishing remarks for each dependent claim at this time.

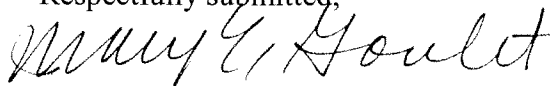
For these several reasons, reconsideration and withdrawal of the obviousness rejection are respectfully sought.

In view of the foregoing, it is respectfully requested that the application be reconsidered, that claims 2, 4-21, 23-30 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis, Christofferson & Cook, P.C.).

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Mary E. Goulet".

Mary E. Goulet
Reg. No. 35,884

Whitham, Curtis, Christofferson & Cook, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190

Tel. (703) 787-9400
Fax. (703) 787-7557

Customer No.: 30743